



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/891,308	07/10/97	ONAGI	N 3577-180

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EXAMINER

CHU, K

ART UNIT

PAPER NUMBER

2752

7 - 8

DATE MAILED: 02/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	08/891,308	ONAGI, NOBUAKI
Examiner	Art Unit	
Kim-Kwok CHU	2752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) Responsive to communication(s) filed on 01 April 1998.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-10 is/are allowed.
- 6) Claim(s) 11-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:
1. received.
2. received in Application No. (Series Code / Serial Number) 08/126,515
3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) Notice of References Cited (PTO-892) 17) Interview Summary (PTO-413) Paper No(s). 4.
- 15) Notice of Draftsperson's Patent Drawing Review (PTO-948) 18) Notice of Informal Patent Application (PTO-152)
- 16) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 19) Other: _____

Reissue Applications

Recapture Claims Rejection

1. Claims 11-23 are rejected under 35 U.S.C. 251 as being an improper recapture of canceled claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

In the amendment dated December 27, 1994, applicant/patentee adds new features:

- (a) "a plurality of information pits recorded on a plurality of recording tracks **as magnetization direction** at the recording surface in a magneto-optical recording operation";
- (b) "the information pits are arranged with such a **high pit density** as to be non-reproducible by a normal resolution reproducible by use of a light spot with a predetermined diameter but reproducible by a super resolution reproduction by **use of a light spot the predetermined diameter**"; and
- (c) "the address pit is **being arranged with such a low pit density** as to be reproducible by a normal resolution

reproduction by use of the light spot of the predetermined diameter" (emphasis added).

The above added features were argued and stated by the applicant/patentee. In response, the examiner allowed the '515 application with claims 1-10.

On the record, the newly submitted claims 11-23 without the aforementioned highlighted features.

In other words, the claims 11-23 are broader than original claims in manner directly pertinent to subject matter surrendered during prosecution.

Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Examiner's attention is directed to MPEP 1412.02 and 1412.03.

ALLOWANCE

2. Claims 1-10 are allowable over the prior art of record.

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3. Any response to this action should be mailed to:
Commissioner of Patents and Trademarks Washington, D.C.
20231
or faxed to:
(703) 305-9051, (for formal communications intended for entry)
Or:
(703) 305-9731, (for informal or draft communications,
please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim CHU whose telephone number is (703) 305-3032.

VC 1/31/2000


ALI NEYZARI
PRIMARY EXAMINER
1-31-2000

Kim-kwok CHU
Examiner AU2752
January 31, 2000

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